REMARKS

Applicants submit this Request for Reconsideration in reply to the final Office Action mailed November 24, 2004.

On pages 2-6 of the Office Action, claims 11, 45, 48, 50-53, and 61 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,666,883 to Seguin et al. ("Seguin") in view of U.S. Patent No. 5,968,052 to Sullivan et al. ("Sullivan"); claims 47 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and further in view of U.S. Patent No. 5,810,837 to Hofman et al. ("Hofman"); claims 54, 55, 62, and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and further in view of U.S. Patent No. 5,306,294 to Winston et al. ("Winston"); and claims 56, 57, 59, 60, 64, 65, 67, and 68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seguin in view of Sullivan and Winston, and further in view of U.S. Patent No. 5,100,381 to Burns ("Burns"). Applicants respectfully traverse these rejections and assert that none of Seguin, Sullivan, Winston, Hofman, or Burns, either individually or in combination, recite every aspect of the claimed invention.

On page 2 of the final Office Action, the Examiner asserted that Seguin discloses "an external tubular structure contact area (the abutment described in col. 5, lines 28-34) which slides against the interior surface of the outer tubular structure 16 since it is radially enlarged relative to the remainder of the inner structure 15." To the extent that the Examiner meant to apply these comments to the aspect of each of claims 11 and 45 which reads "an external tubular structure contact area projecting from a surface of the inner elongated structure and located proximal to the stent accommodating area, the

external tubular structure contact area frictionally sliding against an interior surface of the outer tubular structure," Applicants respectfully traverse this assertion.

Seguin does not disclose the aforementioned aspect of each of claims 11 and 45. Instead, Seguin discloses that the "core 15 comprises an axial abutment such as a shoulder (not visible in FIG. 2) which has a diameter smaller than that of the device 1 when this device is expanded, but greater than the diameter of this device 1 when the latter is contracted. This abutment consequently permits the axial immobilization of the device 1 on the core 15 when the latter is contracted." (Col. 5, lines 27-34). Seguin includes no further disclosure describing the axial abutment. Seguin therefore does not disclose or suggest that the abutment is "proximal to" the device 1, and it is not inherent in Seguin that the abutment is so positioned. It is likely that the abutment in Seguin is located ***distal*** to the device 1 when the device 1 is radially contracted around core 15, so that device 1 would not slide distally out of sheath 16 during insertion of the entire assembly to the treatment site, for example. Were the abutment in Seguin located proximal to the device 1 when the device 1 is radially contracted around core 15, the abutment would not "permit axial immobilization of the device 1" distally.

Indeed, the abutment in Seguin "has a diameter smaller than that of the device when this device 1 is expanded, but greater than the diameter of this device 1 when the latter is contracted" further indicates that the abutment may be distal to device 1. By having a diameter less than the expanded device 1, the abutment can be removed through the device 1 when the device 1 is expanded. If the abutment were proximal to device 1, the diameter of the abutment would not have to be less than the diameter of the expanded device 1, because the abutment would not have to be removed through

expanded device 1. Accordingly, because the Examiner has not shown how the references disclose each and every aspect of the claimed invention, a proper case of *prima facie* obviousness has not been established, and thus Applicants respectfully request withdrawal of the Section 103(a) rejections for this reason above.

On page 2 of the final Office Action, the Examiner admits that "Seguin fail to disclose a translucent region at the distal end of the outer tubular structure 16." The Examiner than asserts, however, that:

> Sullivan et al. teach that the outer tubular structure 14 of a stent delivery system should transmit light therethrough (i.e. be translucent) so that the stent therein may be visually inspected (col. 3, lines 24-33). It would have been obvious to make the outer tubular structure 16 of Seguin et al. translucent so that it too would have this advantage. With this modification, the Seguin et al. translucent outer tubular structure 16 would include a translucent region (between radiopaque rings 21 and 22, for example) which would have a length less than the constrained length of stent 1 as claimed, since radiopaque rings 21 and 22 (like radiopaque rings 42 and 44 on translucent outer tubular structure 14 of Sullivan et al.) are not translucent and thus define ends of a translucent region.

Applicants respectfully disagree. As set forth in the Amendment filed October 7, 2004, even assuming *arguendo* that the retractable outer sheath 14 of Sullivan corresponds to the "the outer tubular structure [having] a translucent region at the distal end," Sullivan does not disclose that "the translucent region has a length less than a constrained length of a stent to be placed within the outer tubular structure," as no embodiment in Sullivan discloses that the retractable outer sheath 14 has a length less than the length of the stent 18.

Even if the "translucent region" of Sullivan were defined as the region between the adjacent marker bands that are proximate the constrained stent, Sullivan does not teach that such a region "has a length less than a constrained length of a stent." The

length of the region between marker bands 36 and 28 is longer than the constrained length of stent 18, as clearly shown in Fig. 3 of Sullivan.

Accordingly, even assuming *arguendo* that the combination of Seguin and Sullivan is proper (e.g., that there is a proper motivation to combine Seguin and Sullivan), the combination would result in the outer tubular structure 16 of Seguin having a translucent region which has a length greater, not less, than the length of device 1. Indeed, Applicants assert the Examiner's selective placement of the translucent region of Sullivan between any of radiopaque markers 20, 21, 22 of Seguin is arbitrary given (1) that the translucent region of the retractable outer sheath 14 of Sullivan extends beyond at least marker band 42, and thus does not necessarily define an "end" of a translucent region, and (2) the translucent region between bands 36, 38 and that covers stent 18 is in fact longer than stent 18. Accordingly, because the Examiner has not shown how the references disclose each and every aspect of the claimed invention, a proper case of *prima facie* obviousness has not been established, and thus Applicants respectfully request withdrawal of the Section 103(a) rejections for this additional reason.

Furthermore, the Examiner has not met the burden of showing how Winston, Hofman, or Burns remedy at least the aformentioned deficiencies of Seguin and Sullivan. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejections.

Claims 47-57, 59-65, 67, and 68 depend from one of independent claims 11 and 45, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, at least some of the dependent

claims recite unique combinations that are neither taught nor suggested by Seguin, Sullivan, Winston, Hofman, or Burns, or other cited art, and therefore are separately patentable.

Applicants respectfully request that this Request for Reconsideration under 37 C.F.R. § 1.116 be considered by the Examiner, placing claims 11, 45, 47-57, 59-65, 67, and 68 in condition for allowance. As the claims have not been amended, this Request for Reconsideration does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed in the claims as examined. Therefore, this Request for Reconsideration should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the consideration of the Request for Reconsideration would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the consideration of this Request for Reconsideration, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The final Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office

Action. For example, on pages 3-4 of the final Office Action, the Examiner asserts that certain features of claim 52 are admitted to be in the prior art. Applicants do not necessarily agree with that assertion and reserve the right to refute the assertion should the need arise. As another example, page 3 of the final Office Action, which refers to claim 51, asserts:

> Seguin et al. fail to disclose the steps of retracting the stent back into the outer tubular structure and then repositioning the stent delivery system. However, retracting the Seguin et al. stent back into the outer tubular structure and then repositioning the stent delivery system when it is determined that the stent is not initially properly positioned would have been obvious since it was well known in this art to so retract and reposition stents for this reason.

Applicants respectfully disagree with this statement as to what is allegedly well known and respectfully request that the Examiner provide evidence to support this assertion.

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Request for Reconsideration and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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